

REMARKS

Restriction Requirement

Applicant hereby confirm the provisional election made on March 3, 2007 and elect the invention of Group II, claims 12-31. Applicant has also canceled claims 15, 16, 23, 30 and 31. Independent claims 12 and 20 and dependent claims 13-14, 17-19, 21-22 and 24-29 (as amended) are currently pending in the application.

Claim Objections

Claims 15-19 and 23-27 are objected to because the structure or proper name of the compounds should be included in the claims. Applicants have amended the claims appropriately.

Claim 13 is objected to because of a typographical error. Applicants have amended the claim to correct the error.

Claims 15-19 and 23-27 have been objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. The claims have been cancelled and/or amended in light of the Examiner's statement.

Double Patenting Rejection

The Examiner has rejected claims 12-14, 21-22, 28 and 29-31 a provisional nonstatutory obviousness-type double patenting rejection over co-pending Application No, 10/369,311. Applicants have amended the claims in the instant application to specify certain apoptosis inhibiting compounds. Applicants believe that the claims as amended are not subject to obviousness-type double patenting as they import the limitations of claims not subject to the double patenting rejection. Regardless, if the double patenting rejection is maintained and patentable subject matter is found, applicant will file the appropriate terminal disclaimer.

Rejections under 35 U.S.C. § 112

1. The Examiner has rejected claims 12-15 and 17-19 under 35 U.S.C. 112, first paragraph because the specification while being enabling for inhibiting caspase-independent apoptosis in a cell by contacting the cell with compound Ucf-101, does not reasonably provide enablement for all apoptosis inhibiting compounds. More specifically, according to the Examiner, the specification does not enable inhibiting caspase-independent apoptosis with the compounds of Fig. 1a, 2a, 2b, 3a, 3b, 4a and 4b. Applicant respectfully disagrees. For the purposes of speeding prosecution and without prejudice, applicant has amended claim 12 to specifically recite compound Ucf-101. According to the Examiner, the claims are enabled for Ucf-101, thereby overcoming the Examiner's rejection. Claims 15 and 16 have been cancelled and claims 17-19, which depend on claim 12, have been amended to recite additional compounds (Ucf-102, Ucf-103, and Ucf-104).

2. The Examiner has rejected claims 20-22 and 28-29 under 35 U.S.C. 112, first paragraph because the specification while being enabling for inhibiting Omi/HtrA2 activity comprising the compounds shown in Figs. 1a, 1b, 2a, 2b, 3a, 3b, 4a and 4b, it does not reasonably provide enablement for all apoptosis inhibiting compounds. Applicants respectfully disagree. For the purposes of speeding prosecution and without prejudice, however, Applicant has cancelled claim 23 and has amended claim 20 to recite the compounds of Figs. 1a, 2a, 3a and 4a as set forth in original claim 23. The compounds shown in FIG. 1b (Ucf-101), FIG. 2b (Ucf-102) FIG. 3b (Ucf-103) and FIG. 4b (Ucf-104) are all species of the compounds recited in amended claim 20. Claims 28 and 28 depend from amended claim 20 and are therefore allowable.

3. The Examiner has rejected claims 30 and 31 under 35 U.S.C. 112, first paragraph because the specification while being enabling for inhibiting caspase-independent apoptosis in a cell comprising the compound Ucf-101, it does not reasonably provide enablement for modifying a disorder associated with caspase-independent apoptosis. Applicants respectfully disagree but for the purpose of speeding prosecution have cancelled claims 30 and 31.

4. The Examiner has also rejected claims 30 and 31 under 35 U.S.C. 112, first paragraph because the specification while being enabling for inhibiting caspase-independent apoptosis in a

cell comprising the compound Ucf-101, it does not reasonably provide enablement for modifying a disorder associated with caspase-independent apoptosis with any apoptosis compound. Applicants respectfully disagree but for the purpose of speeding prosecution have cancelled claims 30 and 31

Rejection under 35 U.S.C. § 102

Claims 12-14, 20-22 28 and 29 are rejected under 102(e) as being anticipated by Alnemri (US 2003/0073629). Applicants respectfully disagree. The Examiner has indicated, however, that claims 15-19 and 23-27 are free from the art and considered allowable. For the purpose of advancing prosecution, independent claims 12 and 20 have been amended to include limitations found in these claims that are consistent with the Examiner's 112 rejection. Consequently the claims as amended are allowable.

Conclusion

In conclusion, Applicant submits that all pending claims are allowable, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed necessary to expedite prosecution of this application.

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Respectfully submitted,

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